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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,513	02/01/2002	Ramarao V. Gundlapalli	1671-0213 (DEP-671)	1804

7590 11/24/2004

Paul J. Maginot  
Maginot, Moore & Bowman  
Bank One Center/Tower, Suite 3000  
111 Monument Circle  
Indianapolis, IN 46204-5115

EXAMINER

PHILOGENE, PEDRO

ART UNIT PAPER NUMBER

3732

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/061,513	<b>Applicant(s)</b> GUNDLAPALLI ET AL.	
	<b>Examiner</b> Pedro Philogene	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wildgoose et al. (5,690,636) in view of Knox (6,332,887).

With respect to claim 1, Wildgoose et al disclose a surgical assembly for preparing a tibia for implantation of a prosthetic implant, comprising: a tray trial (50) adapted to be secured to a proximal end of the tibia and defining a plate opening (55) the plate opening having a center point; and a first guide (61) adapted to be secured to the trial tray.

It is noted that Wildgoose et al did not teach of a guide wherein the first guide defines at least a first bore and a second bore therethrough, each of the first and second bores having a center point arranged to be offset from the center point of the plate opening of the tray trial when the first guide is secured to the tray trial; as claimed by applicant. However, in a similar art, Knox evidences the use of a guide (FIG.10) with first and second bores offset from the center to create overlapping cuts in the selected area.

Therefore, given the teaching of Knox, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the overlapping

bore of Knox in the device of Wildgoose et al to create overlapping cuts in the selected tibia plateau.

With respect to claims 2-10, the above combination of references teaches all the limitations, as set forth in Wildgoose et al., columns 3-7, lines 1-67, and as best seen in FIGS. 1-6; and, Knox, and as best seen in FIG. 10.

With respect to claims 11-18, 21-28, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

With respect to claim 19, Wildgoose et al., disclose a guide for use with a tray trial (50) for implantation of a prosthetic implant, in which the tray trial defines a plate opening (55) therethrough having a center point, the guide device comprising a guide body (61) defining a guide opening (68), means (64,69) for securing the guide body to the tray.

It is noted that Wildgoose et al did not teach of a guide opening including at least a first bore and a second bore therethrough, each of the first and second bores having a center point arranged to be offset from the center point of the plate opening of the tray trial when the first guide is secured to the tray trial; as claimed by applicant. However, in a similar art, Knox evidences the use of a guide (FIG.10) with first and second bores offset from the center to create overlapping cuts in the selected area.

Therefore, given the teaching of Knox, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the overlapping bore of Knox in the device of Wildgoose et al to create overlapping cuts in the selected tibia plateau.

With respect to claim 20, the above combination of references teaches all the limitations, as best seen in the FIGS.

### ***Response to Amendment***

Applicant's arguments filed 9/22/04 have been fully considered but they are not persuasive. Further, applicant stated that a legitimate teaching, suggestion, or incentive has not been identified that would support combining Wildgoose and Knox in the manner proposed. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Knox discloses a guide defining at least a first and second bores (328) therethrough, each of the first and second bores having a center point arranged to be offset from a center point of a plate opening of a tray trial when the guide is secured to the tray trial, as claimed by applicant.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene  
November 19, 2004

  
PEDRO PHILOGENE  
PRIMARY EXAMINER